

Application No. 10/527,241  
Amendment Dated: September 28, 2010  
Reply to Office Action of: August 17, 2010

### **REMARKS/ARGUMENTS**

No amendments are made to the claims.

Upon entry of the response claims 1-25 and 27-30 are pending for reconsideration by the Examiner.

The Examiner has repeatedly rejected Claims 1-13, 24 and 27 -30 under 35 U.S.C. § 103(a) as being obvious by Adler (US Patent 6,256,015 B1). Applicant respectfully traverses the rejections.

Applicant continues to assert that claims 1, 2, and 29 were patentable over the cited Adler reference for the reason that the Examiner has **not** properly applied the legal requirements for the rejections under 35 U.S.C. § 103.

In the current Office Action, on Page 27 the Examiner states:

*"...examiner does not see the patentable difference between a mould and a cover, as the two terms could actually be interpreted to being the same thing; something over the mouse, for example."*

The Examiner would appreciate the following **structural** and functional differences between Adler's cover, correspondingly, the edge of aperture 44, and Applicant's mould.

Adler teaches the cover over the conventional mouse which is **attached to** the mouse **casing**; therefore, a force applied to the **edge** of the aperture/cover (it does **not** matter in which direction and at which **angle**), will **not** actuate the button.

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In contrast, Applicant claims the mould being **attached to** the mouse **button**, thereby allowing button actuating by a force applied tangential to the angled upper surface of the button by the fingertip, when stroking by the fingertip the angled upper surface of the button in the combined down-forward motion **against the mould**.

Further, **contrary** to the Examiner's assertion given in the rejections through the prosecution of the case as follows:

*"Figures 1 and 16 ... show the longitudinal depressions 46L and 46R/146L and 146R, which allow the finger to be placed therein to **contact the apertures 44/144...**" (Emphases added)*

Adler teaches:

*"The depressions 46L and 46R are thus positioned and shaped ... to **align** the tips of the two fingers for **direct contact with** a corresponding one of the **two pushbuttons 20L and 20R**. **In Fig. 2**, the index and middle fingers of a right-handed user 24 are shown positioned in a respective one of the longitudinal depressions 46L, 46R, with the ends of the fingers in respective **direct contact with the push buttons 20L and 20R through** respective **apertures 44**." (Adler, Column 4, Lines 13-22, emphases added).*

Adler does **not** teach, suggest, or motivate **direct contact** for the fingertip with the aperture 44 for the **simple** reason that the edge of the aperture would **hinder** button actuating through the aperture; therefore, the sufficient **clearance**

around the fingertip and edge **must** be provided to allow moving of the fingertip through.

Thus, the **primary** function of the aperture in the cover taught by Adler, correspondingly, **primary reference** in the Adler disclosure is to provide one of the basic functions of the mouse, namely, to allow button actuating through the aperture/cover by the fingertip movement directed **perpendicularly** to the surface of the push button.

Further, in the current Office Action, on Page 27, the Examiner notes:

*"While Applicant argues that it is a paradox of having a hand on the mouse without actuating the button, this seems unclear because Applicant is trying to claim this same feature, so this is confusing as to what is meant here."*

Because of such confusion about this point, which was **clearly** articulated by Applicant, nevertheless mistakably interpreted by the Examiner, it is respectfully submitted, Applicant would like to repeat this argument **once again**.

It is a paradox that the Examiner has the conventional mouse taught in Adler's disclosure in the hand and **not** trying to actuate the button by the tangential movement of the finger, when stroking by the fingertip the upper surface of the button.

It is respectfully, and once **again** submitted, could you **try**, please, right now by reading this response, to **actuate** the button of the conventional mouse, which you have in your hand, by the **tangential movement** of the finger to the surface of the button, when stroking (*gently*) by the fingertip the upper surface of

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the button, in order to prove that there is **no reasonable** expectation of success in actuating the button by the finger movement against **nothing**.

In a view of the Examiner's notes, given in Office Action dated March 2, 2010, Page 27 as follows:

*"Respectfully, the intended use limitations by themselves are only given weight **if the structure can be established as being patentably different** from the prior art. Please see the MPEP on this as well as associated case law."*  
(Original emphases)

The Examiner would **respectfully** appreciate some the MPEP paragraphs relevant on this. Please see the MPEP §2143 and the MPEP §2143.02 citing In re Reinhart, 189 USPQ 143 (CCPA 1976) on this.

First, in a view of the MPEP §2143 and taking into account the discussed above, the Examiner would appreciate that **none** of Adler's reference teaches, suggests, or motivates **any structure, like a mould formed or attached to the button or even to the mouse casing**, which could allow button actuating in the way claimed by Applicant i.e. by the tangential movement of the fingertip, when stroking by the fingertip the upper surface of the button against such structure.

Second, there is **no reasonable** expectation of success in actuating the button of the **conventional** mouse, which is taught in Adler's reference, by the tangential movement of the fingertip, when stroking by the fingertip the upper surface of the button against **nothing**.

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Finally, Adler's reference does **not** teach, suggest, or motivate a **structural limitation**, like a mould attached to the button, which could provide one of the fundamental functions of the mouse, namely, button actuating **in the way claimed by Applicant**.

With respect to the MPEP §2143 Applicant believes that **none** of the criteria to establish a *prima facie* case of obviousness is met by the Examiner in the rejections and cited Adler's reference; therefore, the Examiner's rejections of Claims 1, 2, and 29, it is respectfully submitted, are improper.

Further, in a view of the MPEP §2143.01 (IV) given as follows:

*"Mere statement that the claimed invention is within the capabilities of one of ordinary skill in the art is not sufficient by itself to establish prima facie obviousness."*

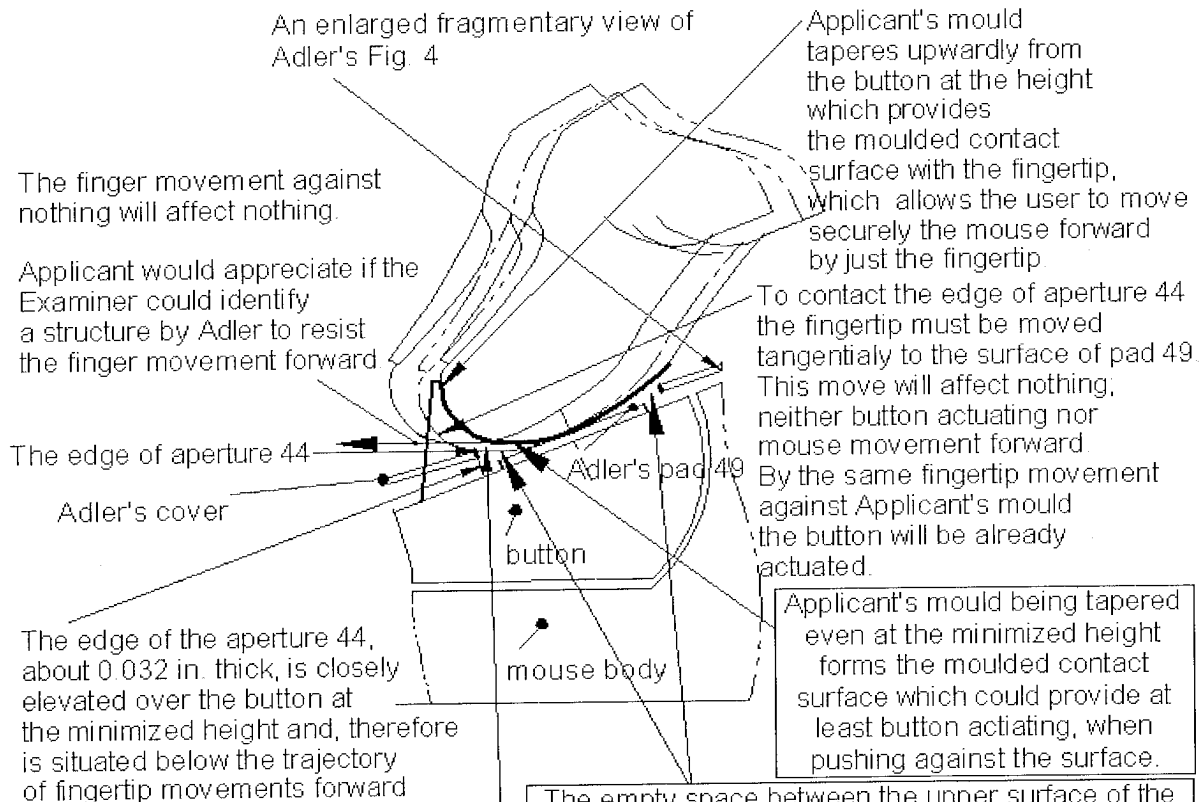
*"Rejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness."* KSR, 550 U.S. at \_\_\_, 82 USPQ2d at 1396 quoting *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006)."

Applicant would appreciate if the Examiner could articulate some reasoning with some rational underpinning to support the **legal** conclusion of obviousness, instead, merely stating in the current Office Action *"The **unmapped** limitations were taught in the obviousness part and examiner believes that the differences were actuated and resolved."*

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Furthermore, Applicant continues to assert that claims 1, 2, and 29 were patentable over the cited Adler reference for the reason that the Adler reference does **not** disclose, teach, suggest, or motivate any structure which could enable the user to move securely the mouse by just the fingertip movement forward.

To support Applicant's assertion and **clearly** demonstrate the **structural differences** between Adler's cover and Applicant's mould, Applicant submits below an annotated fragmentary illustration of Adler's Drawings, Figs. 4, further annotated with an inserted contour of the finger, and further annotated with an inserted contour of the Applicant's mould.



The empty space between the upper surface of the button and the edge of aperture 44 around the fingertip obviously **cannot** be identified as a moulded contact surface for the fingertip with Adler's cover. There is **no** any "groove for forming a mould around the fingertip" as the Examiner asserts. There is only the edge of the aperture which is **not** in direct contact with the fingertip. This **obviously structurally differentiates** Adler's cover and Applicant's mould.

The **primary** function of the aperture is to allow button actuating by the fingertip movement through the aperture directed **perpendicular** to the surface of the push button, therefore the sufficient **clearance** around the fingertip and the edge must be provided to allow the movement.

Once contacted the edge with the fingertip one of skill can **neither** actuate the button, because the edge being placed under the fingertip will hinder depressing the button, **nor** move the mouse forward by the fingertip, because the edge is still below the trajectory of fingertip movements forward.

The Examiner's suggestion to use the edge of the cover being attached to the casing for mouse moving is **conflicting** with the **primary function** of the aperture.

The fingertip contacting of the edge will obviously hinder the fingertip movement through the aperture by button actuating, i.e. "one reference accurately discredits another."

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In the current Office Action, on Page 28 the Examiner states:

*"...examiner does not see a patentable difference as to how a cover **has** to be different from a mould without the appropriate limitations."*

By **considering** the above submitted illustration the Examiner will appreciate the following limitations of Adler's disclosure and Applicants claims.

Applicant claims the mould being **formed or attached on the button**.

The mould **tapers** upwardly from the upper surface of the button at the height, which provides the moulded contact surface for **direct contact** with the fingertip when placed in the mould.

The given dictionary definition for the term "moulded surface" as "***mould** something round a fingertip - to **fit tightly around** the shape of a fingertip*" presumes direct contact for the fingertip with the moulded surface of the button.

As discussed above, Adler does **not** teach, suggest, or motivate **direct contact** for the **fingertip** with the edge of the **aperture**, for the reason that the edge will hinder the fingertip movement through the aperture by button actuating; therefore the sufficient **clearance around the fingertip and the edge must** be provided to allow the movement.

Further, through the prosecution of the case the Examiner continues to state "*Figure 1 shows the groove for forming a mould around the fingertip.*"

Contrary to the Examiner's statement, in the Adler reference and drawings (even **as better seen in the above submitted illustration**) or in the dictionary



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definitions given for the terms “aperture” and “mould” there is clearly **no** proper basis whatsoever for the use such wording in the rejections.

Thus, the Examiner would appreciate that Adler’s Figure 1 shows the **aperture** in Adler’s cover and the **edge** thereof should not be interpreted by on of skill as to being *“the groove for forming a mould around the fingertip.”*

In a view of the MPEP §2144.03 (c) given as follows:

*“If applicant challenges a factual assertion as not properly officially noticed or not properly based upon common knowledge, the examiner must support the finding with adequate evidence.”*

*“If the examiner is relying on personal knowledge to support the finding of what is known in the art, the examiner must provide an affidavit or declaration setting forth specific factual statements and explanation to support the finding. See 37 CFR 1.104(d)(2).”*

Applicant would appreciate if the Examiner could provide the *adequate evidence* in support for the Examiner’s statement that Adler’s aperture, which **must** provide the sufficient **clearance** around the fingertip and the edge of the aperture, and Applicant’s mould, which is **fitted tightly** around the shape of a fingertip, *could actually be interpreted to being the same* structure.

Further, Applicant claims the **height** of the mould, at which the mould **tapers** upwardly from the upper surface of the button, thereby providing the moulded contact surface for direct contact with the fingertip, which allows the

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user to move securely the mouse in the forward direction by **just** the fingertip movement **forward**.

In contrast, Adler teaches the **edge** of the aperture being **closely elevated** over the surface of the button at the **minimized height**.

Because of the small **thickness** of the edge (about 0,032 in. thick), and the **minimized height**, at which the edge is **closely** elevated over the **angled** upper surface button, and the **clearance** provided around the fingertip, the **edge** is **obviously** situated **below** the trajectory of the fingertip movements forward.

Contrary to the Examiner's assertion given through the prosecution of the case "*...the apertures 44/144 ... can also be used for >mouse< movement without the use of the hand or arm and can be done just by moving the two fingers in the grooves*" **the above submitted illustration** clearly **shows** that the **edge** of the aperture being situated below the trajectory of the fingertip movements forward **cannot** be used for mouse movement **just** by moving of the fingertip **forward**.

In a view of the MPEP §2144.03 (c) Applicant would appreciate if the Examiner could provide the *adequate evidence* in support for the statement, given in the current rejections, "*...examiner continues to assert that, because of the grooves in the Adler reference for the fingers to slide into, that mouse movement could be made, in any direction, without actuating the button.*"

To move the mouse by **just** the fingertip movement forward, **as claimed by Applicant**, the Examiner **suggests** using of the edge of Adler's aperture; this

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is **closely** elevated above the button at the **minimized height** and **must be not** in direct **contact** with the **fingertip**.

To contact the edge of the aperture with the fingertip in order to apply the force for mouse moving forward one of skill must **first** overcome the **clearance around the fingertip and edge** by moving of their fingertip **tangentially to**, like stroking, the upper surface of the pad 49 in the combined down-forward motion.

The Examiner would appreciate that this fingertip movement within the **clearance** in the aperture against **nothing** will **affect nothing**; **neither** mouse button actuating **nor** mouse movement forward.

Contrarily, by the **same** fingertip movement against Applicant's mould, which is **fitted tightly** around the shape of a fingertip, the button will be **already actuated** without actuating mouse movement.

Further, once contacted the edge of the aperture with the fingertip one of skill can **neither actuate the button**, because the edge being placed under the fingertip will hinder depressing the button, **nor move the mouse forward by the fingertip**, because the edge is still **bellow** the trajectory of fingertip movements forward, as **it can be clearly seen in the above submitted illustration**.

Furthermore, with respect to the MPEP §2143.01 (II) given as follows:

The Examiner would appreciate that the intended use of the edge of the aperture for mouse moving is **conflicting** with the **primary** function of the aperture in the cover, i.e. with the **primary reference** of the Adler disclosure.

The fingertip contacting of the edge will obviously hinder the fingertip movement through the aperture by button actuating. To **move** the mouse by applying the force to the edge, the fingertip **must** contact the edge; this, in its turn, will **hinder** the fingertip movement through the aperture by button actuating.

Thus, the **Examiner's suggestion to use the edge** of the aperture in the Adler disclosure for mouse moving **seems to make the mouse inoperable** for the use because the contacting of the edge with the fingertip will hinder the finger movement through the aperture by button actuating.

In contrast to Adler's cover/aperture, Applicant's mould being **formed or attached on the button** allows **button actuating** without actuating mouse movement by a force applied **tangential** to the angled upper surface of the button by the fingertip, when stroking by the fingertip the angled upper surface of the button in the combined down-forward motion **against** the moulded contact surface, and **at the same time** allows the user to **move** securely the mouse without button actuating in the **forward** direction by just **moving of one finger** forward.

Taking into account the above discussed **structural** differences between the Adler's cover, correspondingly, the edge of the aperture in the cover and Applicant's mould, the Examiner will appreciate that Adler **cannot** anticipate Applicant's Claims.

Furthermore, as discussed above and **shown** in the submitted illustration, Adler does **not** teach, suggest, or motivate **any structure**, which could **enable**

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the user to **move** securely the mouse by **just moving of one finger** forward or **actuate** the button by the fingertip movement directed **tangentially**, when stroking by the fingertip the surface of the button; therefore, the Examiner's rejections of Claims 1, 2, and 29, it is respectfully submitted, are improper.

Claims 3-25 and 27-30, which depend directly or indirectly in Claims 1 and 2 are patentable for the reasons advanced for Claims 1 and 2.

Applicant submits that the claims as presently submitted very clearly cannot be remotely disclosed, taught, or suggested in the cited Adler reference (or in combination with any other reference cited or identified by the Examiner).

For the reasons discussed herein, Applicant respectfully contends that the Examiner's rejections were improper and respectfully request that the present claims be passed to issuance.

Respectfully Submitted,

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